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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/135,046	10/12/1993	RONALD V. GARVIN		9328

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EXAMINER

CRANE, DANIEL C

ART UNIT	PAPER NUMBER
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3725

DATE MAILED: 04/05/2004

35

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/135,046

Applicant(s)

GARVIN ET AL.

Examiner

Daniel C Crane

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-5 is/are allowed.
- 6) ☒ Claim(s) 6 and 9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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BACKGROUND

This application is the parent of related applicants' Application Serial No. 08/435,144, a division of the present application. Applicants' Application Serial No. 08/435,144 is now ABANDONED in accordance with 37 CFR 1.663. The invention of the present application is similar in inventive concept to that claimed in Application Serial No. 08/435,144.

During the initial prosecution of the present application, applicants became aware of Patent No. 5,345,744 (Cullen) as having interfering subject matter to that claimed in the present application. Allowed claims 7 and 8 in the present application contained interfering subject matter to claims in Patent No. 5,345,744. Applicants withdrew consideration of the indicated allowable claims 7 and 8 in the present application by cancellation thereof and presented the allowable claims, along with additional claims 13 and 14, in a divisional application, Serial No. 08/435,144.

Applicants provoked an interference between the divisional application Serial No. 08/435,144 and Patent No. 5,345,744. Applicants were deemed to be the junior party and the interfering patents were deemed to be the senior party. Accordingly, interference was set up between applicant's Serial No. 08/435,144 and Patent No. 5,345,744. Applicant's application Serial No. 08/435,144 and any related applications, which is the present application Serial No. 08/135,065, were forwarded to the Board of Interferences for a determination of priority of the invention. Prosecution of the present parent application was suspended pending the outcome of the inference proceedings.

A decision on January 15, 2002 was rendered in the interference between the divisional application, Serial No. 08/435,144, and Patent No. 5,345,744 (Cullen) and Patent No. 5,426,910

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(Cullen), a patent added during the interference proceedings. The interference decision was ADVERSE to applicants. Accordingly, applicants are not entitled to the subject matter of claim 1 in Patent No. 5,345,744 and Claims 1, 3 and 4 in Patent No. 5,426,910. Applicant's present parent application was not placed in or added to the interference proceedings.

The present application was returned to the Examining group following the outcome of the interference proceedings since its disposition is still pending. Claims 1-6 and 9 of the present application are still pending and are now up for consideration as a result of the Judgment determined in the Interference rendered on January 15, 2002 between applicants' divisional application, Serial No. 08/435,144 and the interfering patents 5,345,744 and 5,426,910.

REJECTION OF CLAIMS

Claims 6 and 9 are rejected on the grounds of Interference ESTOPPEL. As noted in the above Background, the prosecution in the present application was suspended and the application was forwarded to the Board of Interferences due to its related nature to applicants' interfering application Serial No. 08/435,144 with the Cullen patents 5,345,744 and 5,426,910. The claims that were considered during the interference proceedings were directed to apparatus claims for bagging material. As compared to the present claims 6 and 9, the claims for interference consideration were narrower claims, as they require that the machine have a reel for holding the conduit or pipe for deployment into the filled bag through a feed tube. Claims 6 and 9 of the present application merely require a feed tube be provided for defining a feed path for a conduit being inserted into the filled bag. Claims 6 and 9 have dispensed with the reel. Under 37 CFR

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1.633(c) and (e), a party may file the following preliminary motions:

“(c) A motion to redefine the interfering subject matter by (1) adding or substituting a count, (2) amending an application claim corresponding to a count or adding a claim in the moving party’s application to be designated to correspond to a count, (3) designating an application or patent claim to correspond to a count, (4) designating an application or patent claim as not corresponding to a count, or (5) requiring an opponent who is an applicant to add a claim and to designate the claim to correspond to a count. See § 1.637(a) and (c),” (emphasis added) and

“(e) A motion to declare an additional interference (1) between an additional application not involved in the interference and owned by a party and an opponent’s application or patent involved in the interference or (2) when an interference involves three or more parties, between less than all applications and any patent involved in the interference. See § 1.637 (a) and (e).” (Emphasis added)

Furthermore, under 37 CFR 1.658(c), it is clear on what is expected of the parties entering interference proceedings:

(c) A judgment in an interference settles all issues which (1) were raised and decided in the interference, (2) could have been properly raised and decided in the interference by a motion under § 1.633 (a) through (d) and (f) through (j) or § 1.634, and (3) could have been properly raised and decided in an additional interference with a motion under § 1.633(e). A losing party who could have properly moved, but failed to move, under § 1.633 or 1.634, shall be estopped to take ex parte or inter partes action in the Patent and Trademark Office after the interference which is inconsistent with that

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party's failure to properly move, except that a losing party shall not be estopped with respect to any claims which correspond, or properly could have corresponded, to a count as to which that party was awarded a favorable judgment. (Emphasis added)

It is maintained that applicants had full opportunity to add to the interference proceedings those claims that conflict with the interfering subject matter placed in interference. Accordingly, under the Rules noted above, applicants are ESTOPPED from obtaining claims that could have been placed in interference.

COMMENTS

Applicants' claims 6 and 9 are directed to subject matter that applicants have recognized as similar to that initially claimed by Cullen during the prosecution of Cullen's patents 5,345,744 and 5,426,910. Applicants were further aware that Cullen failed to pursue this claimed subject matter (bagging apparatus with no reel (conduit support)) and that Cullen opted to claim the bagging apparatus with a reel. Applicants have realized this as noted in their response of January 22, 2004, under the heading EXHIBIT A, pages 11-13. Applicants were aware of this and yet continued to pursue the interference between applicants' application Serial No. 08/435,144 and the Cullen patents 5,345,744 and 5,426,910 without moving to add the claims of the present application to the interference proceedings that conflict with the interfering application and patents.

Under 37 CFR 1.633, 1.658 and 1.663, a "losing party who could have properly moved under 37 CFR 1.633 or 1.634, but failed to do so, is estopped from taking subsequent action in the USPTO which is inconsistent with the party's failure to properly move". (See MPEP

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2363.03, under ESTOPPEL). It is maintained that applicants have failed in this endeavor and are therefore ESTOPPED from further action.

While claims 6 and 9 are not identical to the claims of the patents,

“(a)ll that is required under present practice is that a claim of the application be drawn to the same patentable invention as a claim of the patent. An application claim is considered to be drawn to the same patentable invention as a patent claim if it recites subject matter which is the same as (35 USC 102) or obvious in view of (35 USC 103), the subject matter recited in the patent claim. The test is analogous to that applied for double patenting; i.e., if the applicant’s claim would have been subject to a double patenting rejection of the “same invention” or “obviousness” type (see MPEP 804) if the patent and application were by the same inventive entity, then the application and patent claim are directed to the same invention.” (emphasis added) MPEP 2306

Applicants’ claims 6 and 9 clearly qualify for interference with the Cullen patents because the claimed subject matter falls into that category where the subject matter is obvious in view of the subject matter of the patent claims. The elimination or omission of an apparatus feature is a classic obviousness consideration. It is the examiner’s position that in this case the elimination of the pipe support (reel) to facilitate operation on determinate lengths of pipe would have been an obvious modification to the features of the patented claims. It must be remember that for this case, the operation of the apparatus as defined by the patented claims is not effected by the removal of the reel as the positioning means still permits feed of the pipe into the machine and into the bagged material.

Accordingly, the claims 6 and 9 are directed to subject matter that is obvious in view of the patents to Cullen and would have been properly placed in interference with the patents to Cullen. Since applicants have failed to place claims 6 and 9 into interference with the patents during the interference proceedings of applicants’ continuation application (SN 08/435,144) and

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the patents to Cullen and could have done so (MPEP 2307.02), the rejection of claims 6 and 9 on the grounds of ESTOPPEL is tenable.

In light of the fact that the above rejection was not necessitated by applicants' amendment, the Office Action is not made final.

INDICATION OF ALLOWABLE SUBJECT MATTER

Claims 1-5 are allowed as containing subject matter that the claims specify a method for filling and treating material in a bag *inter alia* and further includes a step of providing a vent in the bag in a spaced relation to the conduit perforations so that media flow from the conduit to the vent induces media treatment of the bagged material.

INQUIRIES

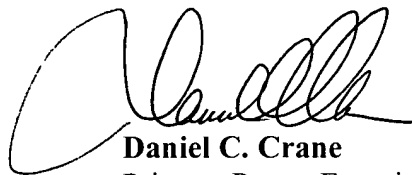
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner D. Crane whose telephone number is (703) 308-1870. The examiner's office hours are 6:30AM-5:00PM, Tuesday through Friday. The examiner's supervisor, Mr. Allen Ostrager, can be reached at (703) 308-3136.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1148.

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Documents related to the instant application may be submitted directly to Group 3700 by facsimile transmission at all times. Applicant(s) is(are) reminded to clearly mark any transmission as "DRAFT" if it is not to be considered as an official response. The Group 3725 Facsimile Center number is **(703) 872-9306**.

DCCrane
March 31, 2004

A handwritten signature in black ink, appearing to read 'DCCrane', is positioned above the printed name and title.

Daniel C. Crane
Primary Patent Examiner
Group Art Unit 3725